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**OFFICE OF PETITIONS**

In re Application of :  
Pressley et al. : DECISION ON PETITION  
Application No. 10/822,550 :  
Filed: April 12, 2004 :  
Atty Docket No. 12077US06 :

This is a decision on the PETITION AND RESPONSE TO NOTICE OF OMITTED ITEMS IN A NONPROVISIONAL APPLICATION, filed August 1, 2005, requesting that the above-identified application be amended to include a drawing containing Figure 6<sup>1</sup>.

Application papers in the above-identified application were deposited on April 12, 2004. However, on June 1, 2005, the Initial Patent Examination Division mailed applicants a "Notice of Omitted Items in a Nonprovisional Application," notifying

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<sup>1</sup> Petitioner is advised that effective September 21, 2004, (to apply to applications filed on or after September 21, 2004) 37 C.F.R. § 1.57 was added to read, in pertinent part that:

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains ... a claim under 1.78 for the benefit of a prior-filed provisional, nonprovisional or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under ... § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier; ...

applicants that the application papers had been accorded a filing date of April 12, 2004; however, figure 6 described in the specification appeared to have been omitted.

In response, the present petition was timely filed requesting, in effect, that the application be amended to include the drawing of Figure 6 described in the specification.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(f)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioners neither assert that the missing drawing figure was deposited on April 12, 2004, nor request the August 1, 2005 (the date the drawing was supplied) filing date.

Instead, applicants seek to amend the application to include the drawing figure. However, no petition under 37 CFR 1.182 is necessary for that purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded as the petition was not necessary to correct any error on the part of the Office.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 09/763,676 and specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:


... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figure 6 is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of April 12, 2004, including an indication in Office records that 5 sheets of drawings were present on filing.

Thereafter, the application will be forwarded to the appropriate group art unit for consideration by the examiner of the petition filed August 1, 2005, as an amendment requesting entry of a new drawing sheet.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
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Office of Petitions